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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/745,763	12/22/2000	Kenneth Jacobs	GIN-6046CP	7028

959 7590 05/13/2003

LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

EXAMINER

KAM, CHIH MIN

ART UNIT	PAPER NUMBER
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1653

DATE MAILED: 05/13/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/745,763

Applicant(s)

JACOBS ET AL.

Examiner

Chih-Min Kam

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13, 14, 37, 44, 102, 103, 117, 124, 171, 172, 206, 207, 250 and 251 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 13, 14, 37, 44, 102, 103, 117, 124, 171, 172, 206, 207, 250 and 251 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1653

DETAILED ACTION

The prior Office Action on restriction of the instant inventions mailed September 27, 2002 (Paper No. 8) is vacated because a Preliminary amendment has been filed on December 20, 2000, in which claims 1-12, 15-36, 38-43, 45-101, 104-116, 118-123, 125-170, 173-205, 208-249 and 252-264 have been canceled. Therefore, claims 13, 14, 37, 44, 102, 103, 117, 124, 171, 172, 206, 207, 250 and 251 are pending and restricted.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U. S. C. 121:
 - 1) Inventions of Set I. Inventions 1-7 (claims for each invention and the related "SEQ ID NO:" are listed below), are drawn to an isolated polynucleotide comprising or related to a specific nucleotide sequence identified by "SEQ ID NO:", classified in class 536, subclass 23.1.

Invention	Claims	SEQ ID NO:
1	13	3
2	37	33
3	102	76
4	117	99
5	171	137
6	206	165
7	250	198

Should Inventions of Set I be elected, applicant is required to select one nucleotide sequence identified by "SEQ ID NO:" for examination. Each polynucleotide is patentably distinct from each other because polynucleotides encoding different proteins are structurally distinct chemical compounds and are unrelated to each other.

- 2). Inventions of Set II. Inventions 8-14 (claims for each invention and the related "SEQ ID NO:" are listed below), drawn to a protein comprising or related to an amino

Art Unit: 1653

acid sequence identified by "SEQ ID NO:", classified in class 530, subclasses 324 and 350.

Invention	Claims	SEQ ID NO:
8	14	4
9	44	34
10	103	77
11	124	100
12	172	138
13	207	166
14	251	199

Should Inventions of Set II be elected, applicant is required to select one amino acid sequence identified by "SEQ ID NO:" for examination. Each protein containing different amino acid sequence is patentably distinct from each other because each amino acid sequence has different chemical and physical properties as well as different function.

2. The inventions are distinct, each from the other because of the following reasons:

The polynucleotides of Inventions of Set I are related to the proteins of Inventions of Set II because the polynucleotide encodes the claimed protein. The inventions are distinct because they are physically and functionally distinct chemical entities, and the protein can be made by another and materially different process such as chemical peptide synthesis. Furthermore, the polynucleotide can be used for a process other than the production of the protein such as nucleotide hybridization assay.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification and recognized divergent subject matter, and because Inventions of Sets I-II require different searches but are not co-

Art Unit: 1653

extensive, examination of these distinct inventions would pose a serious burden on the examiner and therefore restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

A telephone call was made to Lawrence Perry on May 6, 2003 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Application/Control Number: 09/745,763

Page 5

Art Unit: 1653

Chih-Min Kam, Ph. D. *CMK*
Patent Examiner

May 6, 2003

Christopher S. Low
CHRISTOPHER S. F. LOW
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 1600